

REMARKS

Claims 17 to 30 are currently pending and being considered in the present application (claims 10 to 16 were previously withdrawn in response to a restriction requirement).

Reconsideration is respectfully requested based on the following.

Claims 24 and 30 were rejected under 35 U.S.C. § 112, first paragraph, as to the best mode requirement.

The rejections are not understood. It is respectfully submitted that the specification discloses the best mode of the subject matter of claims 24 and 30 (and their feature of a device having data terminal programs for vehicle-related services) at page 4, lines 1 to 10, and at page 8, lines 30 to 35, of the present application. It is therefore respectfully requested that these rejections be withdrawn as to claims 24 and 30.

Claims 17 to 19, 24 to 28 and 30 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Application No. 2002/0049535 to Rigo et al., ("Rigo"). *Paper Number 20080507, p. 4.*

As a technical matter, Rigo is not a 102(b) reference, since the present application has a priority date of June 10, 2002. The Rigo reference published April 25, 2002, which is less than one year prior to the effective date of application for patent in the United States.

To reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejection, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully

submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 18 now includes the features of claim 17.

The Rigo reference concerns a wireless interactive voice-actuated mobile information system permits a motorist to obtain information and assistance, hands free, using voice technology and the Internet. An on-board telematics unit in a motor vehicle connects using wireless (cellular) communications with the Internet while the vehicle is underway. A G.P.S. locating circuit is coupled to the on-board telematics unit. An interactive voice net off board station is connected via Internet to communicate wirelessly with the on-board unit. Commercial subscribers including, restaurants, hotels, etc., maintain a connection to the central station. The on-board computer communicates the geographical position and direction of travel to central station to obtain restaurant or hotel information, which the telematics unit communicates using voice technology with the person in the vehicle. A person can make and confirm lodging and communicate payment data to a selected restaurant or hotel. The system operates unattended at the subscriber end. (See Rigo, Abstract).

Accordingly, Rigo does not identically describe (or suggest) the feature of “a same application protocol being used both for the transmission via the wireless communication and for communication in the vehicle,” as provided for in the context of claims 17 and 18.

In particular, Rigo refers to an auxiliary devices or circuits that allow Smartcards, PDAs, small cell phones, and/or a printer to be linked via wireline or short-range wireless with the telematics unit to aid the motorist in inputting, receipt, storage, and retrieval of information. (*Rigo [0023]*). The telematics unit 32 connects wirelessly to carry voice and data between the unit 32 and a wireless communication protocol adapter 201 at the off-board computing facility or central station 22. (*Rigo [0048]*). The application protocol adapter 203 at the central station 22 are wireline-connected to a central reservation system computer 281 for a first hotel system. Conspicuously, Rigo is wholly silent as to the feature of a same application layer protocol being used both for the transmission via the wireless communication and for communication in the vehicle. Even if the Rigo reference may refer to an application protocol adapter within its system, it is unclear as to which protocol -- if any -- that the application protocol adapter uses. The necessary provider services information, data, reservation booking software, and point of sale software resides on the provider's proprietary central reservation system. Further, the application protocol adapter is not present

within the vehicle system, since it is a part of the off board computing facility or central station. (*Rigo* [0048], [0050]). Even if *Rigo* may refer to a short ranged wireless or landwire coupled with the telematic unit and a wireless connection between the telematic unit and a wireless communication protocol adapter located at a central station (*Rigo*, [0023], [0048]), the communication medium of short range wireless, landwire, and wireless does not identically disclose nor suggest any form of protocol -- let alone a same application protocol being used both for the transmission via the wireless communication and for communication in the vehicle, as provided for in the context of claims 17 and 18.

Accordingly, claims 17 and 18 are allowable, as are the dependent claims 19 to 30, which depend from claim 17 or claim 18.

Additionally, *Rigo* does not identically describe (or suggest) the feature of “the transport protocol prescribes timing conditions that, using an arrangement of the data terminal, are considerably shorter than are able to be realized via the wireless communication,” as in claim 19.

In particular, *Rigo* does not specifically disclose a transport protocol within its system. The Office Action conclusorily asserts that a transport protocol is provided between a control unit and a data terminal, and that the transport protocol requires the following of timing conditions when transmitting and/or receiving signals. *Paper Number 20080507, p. 4*. It is respectfully submitted that even if a transport layer may be used in telecommunications systems, not all wireless communications applications involve transport protocols. In the present case, *Rigo* does not identically disclose the use of a transport protocol, as provided for in the context of claims 17 and 18. Moreover, *Rigo* is wholly silent regarding the transport protocol prescribes timing conditions that are considerably shorter than are able to be realized via the wireless communication.

As such, claim 19 is allowable for this further reason, as are its dependent claims 20 to 24.

Claim 22 and 28 were rejected under 35 U.S.C. 103(a) as unpatentable over *Rigo* in view of U.S. Patent No. 6,640,238 to Bowman-Amuah. (“Bowman”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This

teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679 (Fed. Cir. 1998).

The Bowman document refers to a system, method, and article of manufacture provide for an activity module. A server and a presentation interface of a client are interfaced to permit the receipt of requests for service from the presentation interface of the client. A portion of the requests are handled on the client. Another portion of the requests are forwarded to the server for further handling purposes and changes are effected in the presentation interface. (*Bowman, Abstract*). The Bowman reference does not disclose nor suggest any of the features described above as to claims 17 and 18, and does not disclose nor suggest that the deficiencies of Rigo should be remedied or changed in any way to provide the presently claims subject matter. Accordingly, claims 22 and 28 are allowable for essentially the same reasons as claims 17 and 18.

Accordingly, claims 17 to 30 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
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